

REMARKS

In the Final Office Action, the Examiner repeated the rejection of claims 1-6, 11-31, 34-35, and 37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,212,684 to MacNamee et al. ("MacNamee") and the rejection of claims 32, 33, and 36 under 35 U.S.C. § 103(a) as being unpatentable over MacNamee and further in view of Applicant's admitted prior art ("AAPA"). Applicant respectfully traverses the rejection for the following reasons.

Procedural Issues Regarding the Rejection

The Final Office Action is a substantial duplicate of the February 25, 2004, Office Action, as the Examiner has applied the same arguments almost verbatim identical to how they appeared in the previous Office Action. In the Final Office Action, however, the Examiner did not address the substance of Applicant's arguments presented in the Amendment of August 19, 2004. The Examiner applied the same rejection, notwithstanding the Examiner's own admission of the deficiencies of MacNamee.

That being said, Applicant respectfully points out that the M.P.E.P. requires that, "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, *take note of the applicant's argument and answer the substance of it.*" M.P.E.P. § 707.07(f) (8th Ed., Rev. 2, May 2004) (emphasis added). Applicant respectfully submits that the Final Office Action does not address any of Applicant's remarks from the Amendment of August 19, 2004, made to rebut the alleged *prima facie* case of obviousness. The Examiner did nothing more than refer to "the reasons given in the Office Action" in response to Applicant's remarks. See Final Office Action,

page 4. Therefore, the Examiner has not answered the substance of Applicant's remarks.

Even if the Examiner has made a case of *prima facie* obviousness (which Applicant disputes), Applicant respectfully points out to the Examiner that:

"When *prima facie* obviousness is established and *evidence is submitted in rebuttal, the decision-maker must start over*. ...[T]he question of whether that burden has been successfully carried requires that the entire path to decision be retraced. *An earlier decision should not, as it was here, be considered as set in concrete, and applicant's rebuttal evidence then be evaluated only on its knockdown ability*. Analytical fixation on an earlier decision can tend to provide that decision with an undeservedly broadened umbrella effect. *Prima facie* obviousness is a legal conclusion, not a fact. *Facts established by rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, not against the conclusion itself.*" In re Rinehart, 189 USPQ 143, 147 (CCPA 1976) (emphasis added).

In addition, Applicant respectfully points out that "[i]f rebuttal evidence of adequate weight is produced, the holding of *prima facie* obviousness, being but a legal inference from previously uncontradicted evidence, is dissipated. *Regardless of whether the prima facie case would have been characterized as strong or weak, the examiner must consider all of the evidence anew.*" In re Piasecki and Meyers, 223 USPQ 785, 788 (Fed. Cir. 1984) (emphasis added). Applicant therefore respectfully submits that the Examiner cannot use the rebutted rejection of the claims from the previous Office Action as a platform to sustain a rejection of the claims in the Final Office Action on the same grounds.

Therefore, should the Examiner maintain any rejection of the claims after consideration of this Request for Reconsideration after Final, Applicant respectfully requests that the Examiner withdraw the finality of the rejection and reopen prosecution of the present application. This would give Applicant a fair opportunity to review comments, feedback, or responsive arguments from the Examiner, and help Applicant advance the prosecution of the present application. Applicant respectfully submits that his ability to respond to the outstanding Final Office Action is impeded by the lack of response to his previously presented arguments rebutting the alleged *prima facie* case of obviousness.

Substantive Issues Regarding the Rejection:

Applicant respectfully traverses the rejection of claims 1-6, 11-31, 34-35, and 37 under 35 U.S.C. § 103(a) as unpatentable over MacNamee. Applicant respectfully disagrees with the Examiner's arguments and conclusions, and respectfully submits that a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, all the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03 (8th Ed., Rev. 2, May 2004). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, not in applicant's disclosure." M.P.E.P. § 2143 (8th Ed., Rev. 2, May 2004).

No *prima facie* case of obviousness has been established with respect to independent claims 1-6, 11-31, 34-35, and 37 for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims. For example, independent claim 1 recites, among other things, “notifying unit configured to notify a connected another communication apparatus of a number of usable channels based on a negotiation between the communication apparatus and a relay station being connected to the communication apparatus.”

The Examiner incorrectly alleged that MacNamee depicts, in FIG. 5 at 38 and 40, the “notifying unit,” as recited in claim 1. Rather than the claim 1 “notifying unit,” MacNamee merely depicts, in FIG. 5, an antenna 40 and an RF section 38 in a secondary station 14. See MacNamee FIG. 5 and col. 5, lines 48-53. MacNamee also discloses that multiplexer/demultiplexer 34 in secondary station 14 is “controlled to *select* the complementary TDD (receive) slot to the (transmit) one selected by the primary station.” MacNamee, col. 5, lines 40-45. A structure that *selects* a TDD slot based on a slot detected by a primary station cannot possibly constitute a structure that notifies **“another communication apparatus of a number of usable channels based on a negotiation between the communication apparatus and a relay station being connected to the communication apparatus,”** as required by claim 1.

For at least these reasons, MacNamee fails to disclose a combination including at least a “notifying unit configured to notify a connected another communication apparatus of a number of usable channels based on a negotiation between the

communication apparatus and a relay station being connected to the communication apparatus."

Moreover, the Examiner's modifications to MacNamee fail to cure its deficiencies. Therefore, claim 1 is allowable over MacNamee, and the 35 U.S.C. § 103(a) rejection of claim 1 and claims 2-5 and 19-22, at least by their dependency from claim 1, should be withdrawn.

Moreover, the Examiner acknowledges that MacNamee does not explicitly teach the claim 1 "selecting the data rate based on the number of channels" at the other communication apparatus. See Final Office Action, pages 2-3. Indeed, MacNamee merely depicts communications between a primary station 10 and a secondary station 13. As such, **MacNamee fails to describe any type of negotiation with another communication device.** However, the Examiner ignores the deficiencies of MacNamee and then appears to take Official Notice to fill such clear gaps in MacNamee. Applicant traverses any such Official Notice that may be taken by the Examiner and submits that there is no basis for considering the Examiner's statements to constitute common knowledge or to be well-known in the art because MacNamee does not disclose any such information and the Examiner has not cited any reference that teaches or suggests modifying MacNamee to cure its deficiencies. Therefore, Applicant respectfully requests that the Examiner either cite a prior art reference to support his assertions or withdraw the rejection. "If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence if the rejection is to be maintained." M.P.E.P. § 2144.03(C) (8th Ed., Rev. 2, May 2004). Absent a factual basis placed on the record for the Examiner's taking of Official Notice,

the rejection under 35 U.S.C. § 103(a) of claim 1 and claims 2-5 and 19-22, by their dependency from allowable claim 1, should be withdrawn for this additional reason.

Independent claims 6, 23, and 28, although of different scope, include recitations similar to those of claim 1. Claims 11-18, 24-27, and 29 depend from claims 6, 23, and 28, respectively. For at least the reasons given above with respect to allowable claim 1, claims 6, 11-18, and 23-29 are allowable over MacNamee, and the rejection of those claims under 35 U.S.C. § 103(a) should be withdrawn.

Independent claim 30 recites a combination of elements including, *inter alia*, “obtaining unit configured to obtain a first number of usable channels based on a first negotiation between the communication apparatus and a first base station being connected to the communication apparatus.” Independent claim 31 recites a combination of elements including, *inter alia*, “obtaining unit configured to obtain a first number of usable channels based on a first negotiation between the communication apparatus and a first station of the network, the first station being connected to the communication apparatus.” Independent claim 34 recites a combination including, *inter alia*, “obtaining unit configured to obtain a first usable data rate based on a first negotiation between the communication apparatus and a first base station being connected to the communication apparatus.” Independent claim 35 recites a combination including, *inter alia*, “obtaining unit configured to obtain a first usable data rate based on a first negotiation between the communication apparatus and a first station of the network, the first station being connected to the communication apparatus.” Independent claim 37 recites a combination including, *inter alia*, “determining unit configured to determine a first usable data rate between the first

communication apparatus and a first base station being connected to the first communication apparatus based on a total data rate of idle channels of the first base station.” For at least the reasons given above with respect to claim 1, MacNamee fails to disclose or suggest at least these elements of each of independent claims 30, 31, 34, 35, and 37. Moreover, as explained above, there is no basis for the Examiner’s modifications to MacNamee to overcome its deficiencies admitted by the Examiner. Therefore, the rejection of independent claims 30, 31, 34, 35, and 37 under 35 U.S.C. § 103(a) should be withdrawn.

Applicant respectfully traverses the rejection of claims 32, 33, and 36 under 35 U.S.C. § 103(a) as unpatentable over MacNamee and further in view of AAPA.

Claim 32 is directed to a method comprising a combination including, for example, determining a first number of usable channels between the first communication apparatus and a first base station being connected to the first communication apparatus based on a number of idle channels of the first base station, and determining a second number of usable channels between the second communication apparatus and a second base station being connected to the second communication apparatus based on a number of idle channels of the second base station. Moreover, claim 32 recites determining the communication rate based on the first number of usable channels and the second number of usable channels.

For at least the reasons given above with respect to claim 1, MacNamee fails to disclose or suggest “determining a first number of usable channels between the first communication apparatus and a first base station being connected to the first communication apparatus based on a number of idle channels of the first base station,”

as recited in claim 32. AAPA fails to cure the deficiencies of MacNamee. The Examiner relied on page 3, line 13 of AAPA for its alleged teaching of using idle channels to determine a first number of usable channels. See Final Office Action, page 4. Applicant respectfully disagrees with the Examiner's characterization of AAPA. AAPA discloses a base station assigning idle TCHs to a "calling" mobile station. See Specification, page 3, lines 13-14. Assigning idle TCHs to a mobile station does not constitute "determining a first number of usable channels between the first communication apparatus and a first base station being connected to the first communication apparatus based on a number of idle channels of the first base station," as recited in claim 32.

Moreover, the Examiner acknowledges that MacNamee does not teach "a communication apparatus at the opposite end." See Final Office Action, page 2. As such, MacNamee fails to also disclose or suggest the claim 32 step of "determining a second number of usable channels between the second communication apparatus and a second base station." Lastly, because MacNamee fails to disclose or suggest the use of a "second communication apparatus," MacNamee cannot possibly teach or suggest the claim 32 step of "determining the communication rate based on the first number of usable channels and the second number of usable channels." For at least these reasons, MacNamee and AAPA, taken alone or in combination, fail to disclose or suggest each and every element of claim 32. Therefore, the rejection of claim 32 under 35 U.S.C. § 103(a) should be withdrawn for this additional reason.

Moreover, the Examiner has not met the three requirements for making a *prima facie* case of obviousness. First, the references, taken alone or in combination, fail to

teach or suggest each and every element recited in claim 32. Specifically, MacNamee and AAPA, taken alone or in combination, fail to disclose or suggest each and every element recited in claim 32. Second, the Examiner has failed to identify any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references in a manner resulting in the claimed invention. Specifically, the Examiner has merely used impermissible hindsight reasoning to reconstruct the MacNamee reference by stating that such a modification "provide[s] an optimum use of channel resources ... and provide[s] the best traffic throughput." Final Office Action, page 4. Third, the Examiner has failed to make any showing of a reasonable expectation of success that the proposed modification of MacNamee or its combination with AAPA will work for the intended purpose. Moreover, each of the *prima facie* obviousness requirements must be found in the prior art, and not be based on Applicant's disclosure. M.P.E.P. § 2143 (8th Ed., Rev. 2, May 2004). Absent these showings by the Examiner, the rejection of claim 32 under 35 U.S.C. § 103(a) should be withdrawn for this additional reason.

Independent claims 33 and 36, although of different scope, include recitations that are similar to those of claim 32. For at least the reasons given above with respect to claim 32, the rejection of claims 33 and 36 under 35 U.S.C. § 103(a) should be withdrawn for this additional reason.

Conclusion

In view of the foregoing remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Should the Examiner continue to dispute the patentability of the claims after consideration of this Request, Applicant encourages the Examiner to contact Applicant's undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings. Applicant's undersigned representative would welcome the opportunity to discuss the merits of the present invention with the Examiner if telephone communication will aid in advancing prosecution of the present application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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